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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91211312
Party	Defendant So Within Reach, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GRUBHUB, INC.,)	
a Delaware corporation,)	
)	
Opposer,)	Opposition No. 91211312
)	Serial No. 85/820,352
v.)	
)	
SO WITHIN REACH, LLC,)	
an Alabama limited liability company,)	
)	
Applicant.)	
)	

ANSWER TO NOTICE OF OPPOSITION

COMES NOW the Applicant, So Within Reach, LLC to Answer the Notice of Opposition. Any allegation not specifically admitted herein is denied. Applicant specifically denies any confusing similarity or damage to Opposer.

The numbered allegations are answered as follows:

1. Regarding Opposer's claims of ownership of named registrations, Applicant Answers as follows:
 - a. It is admitted that Opposer claims ownership of the servicemark GRUBHUB for "Advertising and commercial information services, via the internet" in International Commerce Class 35. Applicant denies any further ownership claimed by Opposer not specifically defined in the already overly broad above-stated goods and services description.
 - b. It is admitted that Opposer claims ownership of the trademark GRUBHUB for "Printed publications, namely, informational brochures, booklets, forms and flyers featuring information about how to advertise goods and services in the

marketplace; folders; stickers, namely, bumper stickers and decals for windows; coasters made of paper; coasters made of cardboard; document portfolios and document folders made of imitation leather; pens” in International Commerce Class 16. Applicant denies any further ownership claimed by Opposer not specifically defined in the above-stated goods and services description.

- c. It is admitted that Opposer claims ownership of the trademark GRUBHUB for “Shirts; underwear; outerwear in the nature of rain wear” in International Commerce Class 25. Applicant denies any further ownership claimed by Opposer not specifically defined in the above-stated goods and services description.
- d. It is admitted with clarification that Opposer claims ownership of the stylized servicemark “grubHub” in which the only capitalized letter is “H”. It is admitted that this claim is specifically for “Advertising services via the internet; Providing consumer information, namely ratings and reviews of restaurants and compilations of ratings and reviews of restaurants; On-line advertising and marketing services for restaurants, namely, social media, internet and mobile marketing; Customer service, namely responding to customer inquiries for others in the field of restaurant delivery and carry-out” in International Commerce Class 35. Applicant denies any further ownership claimed by Opposer not specifically defined in the above-stated goods and services description.

2. Regarding Opposer's claims of ownership of named applications, Applicant Answers as follows:

- a. It is admitted that Opposer claims ownership of the named pending application for the trademark and servicemark GRUBHUB for "Decorative magnets; downloadable software in the nature of mobile applications, namely software for use in facilitating the advertising and marketing of restaurants to consumers, for accessing restaurant menus, for placing restaurant orders, for monitoring the status and/or location of restaurant orders, and for assisting restaurant delivery operators with mapping, planning, and tracking their orders, trips, and finances" in International Commerce Class 9.

It is admitted that Opposer claims ownership of the named pending application for the trademark and servicemark GRUBHUB for "Providing websites featuring temporary use of non-downloadable software, namely, software for use in facilitating the advertising and marketing of restaurants to consumers, for accessing restaurant menus, for placing restaurant orders, for monitoring the status and/or location of restaurant orders, and for restaurants to manage customer order information" in International Commerce Class 42.

- b. It is admitted that Opposer claims ownership of the named pending application for the trademark GRUBHUB for "Cups and mugs" in International Commerce Class 21.

3. It is admitted that Opposer claims ownership of the nine-named registrations but Applicant has no knowledge of any further applications or registrations under the alleged ownership of Opposer; therefore Applicant denies the implication without

evidence that further ownership exists. Additionally, Opposer has not made copies of those Certificates of Record in an appropriate way; therefore Applicant denies the remaining allegations. Applicant will leave Opposer to its proofs.

4. Admitted with the clarification that Applicant has submitted Change of Owner's Address form to the United States Patent and Trademark Office dated July 8, 2013. The new principal place of business of Applicant pending filing of Amendment to Formation/Organization with the State of Alabama is 22893 Country Ridge Parkway, McCalla, Alabama, 35111, UNITED STATES.
5. Admitted.

COUNT I

There is Not Currently and Never Will Be a Likelihood of Confusion

6. The balance of all allegations set forth in paragraphs 1 through 5 which were not expressly admitted by Applicant is denied.
7. Denied. Opposer cites cases in which both opposer and defendant are in exceedingly similar lines of business with overlapping target markets. Applicant strongly emphasizes the obvious dissimilarity in lines of business and target markets pursued by Opposer and Applicant in this case. The target market of Applicant consists of business owners and professionals who seek advice they could not otherwise afford if they were to employ consultants. There is no overlap between Applicant's target market and that of Opposer. No member of Applicant's target market is likely to identify "GRUB," which is a synonym for "food," as a reasonable descriptor of a source of business advice. Similarly, no person seeking to order food online is likely

to identify "GURU," which is a synonym for "expert," as a reasonable descriptor of a food ordering service.

8. Denied. Applicant's mark and Opposer's mark differ by three letters and have remarkably different pronunciations. "GuruHub" consists of three syllables. "grubHub" consists of two syllables. Opposer's usage of its mark is traditionally with the first letter non-capitalized making it further visually distinguishable. Both syllables of "grubHub" rhyme, creating still further aural uniqueness.

Applicant's mark is not audibly similar to any alleged trademark of Opposer. "GuruHub" does not sound like "grubHub". Even so, confusion about the pronunciation of a mark does not necessarily create confusion about the source of goods and services offered. (See *Lebow Bros., Inc. v. Lebole Euroconf. S.p.A.*, 503 F. Supp. 209, 212 U.S.P.Q.693, 695 (E.D. Pa. 1980).)

Where marks in dispute consist of common words which are well-known to the public, even a slight difference in sound or appearance can suffice to avoid conflict. (See *Playboy Enters., Inc. v. Chuckleberry Publ'g, Inc.*, 486 F. Supp. 414, 206 U.S.P.Q. 70, 76 (S.D.N.Y. 1980), citing cases; *E.R. Squibb & Sons, Inc. v. Cooper Labs.*, 536 F. Supp. 523, 214 U.S.P.Q. 441, 450 (S.D.N.Y. 1982); *Racemark Int'l, Inc. v. Specialty Prods., Inc.*, 217 U.S.P.Q. 772, 779) "Guru," "grub," and "hub" are all words with meanings well-known to the public.

Without admitting that Applicant's mark is similar to Opposer's mark, a close similarity between marks is not dispositive. Confusion is deemed unlikely when context is taken into consideration. There is no viable relationship between the services offered by Applicant and those offered by Opposer. Applicant's mark and

Opposer's mark are remarkably different in meaning. (See *In re Opus One*, 60 U.S.P.Q.2d 1812, 1815 (T.T.A.B. 2001); *In re Concordia Int'l Forwarding Corp.*, 222 U.S.P.Q. 355, 356 (T.T.A.B.)

9. Denied. The computer services listed in the Application are not similar to any grubHub Mark services. Each allegation of such is answered as follows:
 - a. Denied. Applicant does not provide online non-downloadable software that allows members to manage their customer order information using mobile devices. Applicant's online platform is intended strictly to enable social interaction among business owners and professionals. No customer order information is gathered or processed in any form.
 - b. Denied. As a social media platform, Applicant services do not include the design and development of computer software in the field of restaurant delivery/carryout or customer service and mobile applications that would perform any customer order processing. Nor do Applicant services involve the storing of restaurant menus or business inventory or service summaries of any kind meant for consumer use.
 - c. Denied. The description "On-line advertising and marketing services" is itself too broad for Opposer to effectively defend without over-reaching into fields where there is clearly no conflict. Nonetheless, Applicant does not intend to perform advertising or marketing services for its members.
 - d. Denied. Applicant services do not provide software to be used strictly by delivery drivers of any business for any reason.

- e. Denied. Applicant's target market excludes consumers of restaurants as such. Applicant services do not provide consumer information regarding ratings and reviews of restaurants or compilations of ratings and reviews of restaurants. Applicant services do not provide on-line advertising and marketing services for restaurants. Applicant services do not provide customer service regarding customer inquiries for others in the field of restaurant delivery and carry-out.
- f. Denied. Opposer is over-reaching beyond a reasonable interpretation of the scope of the rights legitimately granted to the alleged trademark owner.
- g. Denied. Opposer is over-reaching beyond a reasonable interpretation of the scope of the rights legitimately granted to the alleged trademark owner.
- h. Denied. Applicant does not intend to perform advertising or marketing services for its members.
- i. Denied. Applicant services do not include advertising or marketing of restaurants to consumers, provision of methods of: 1) access to restaurant menus, 2) placing of restaurant orders, 3) monitoring status and/or location of restaurant orders, or any functionality allotted to delivery drivers of any business for any reason.
- j. Denied. Applicant services do not include advertising or marketing of restaurants to consumers, provision of methods of: 1) access to restaurant menus, 2) placing of restaurant orders, 3) monitoring status and/or location of restaurant orders, 4) management of any member's customer information.

10. The Application should be advanced because the proposed mark in the Application (GURUHUB), it not similar enough in sight or sound to any mark allegedly owned by

Opposer nor is Opposer in any line of business where confusion of marks would be possible. Applicant denies and rejects the notion that use of its mark in connection with its own differentiated services would be likely to cause confusion, or to cause mistake, or to deceive.

AFFIRMATIVE DEFENSES

1. The Notice of Opposition fails to state a claim upon which relief can be granted.
2. There is no likelihood of confusion, mistake, or deception because, inter alia, Applicant's mark is not confusingly similar in sight, sound, or meaning to any alleged mark of Opposer.
3. Alternatively, any similarity between Applicant's mark and Opposer's alleged marks is restricted to that portion of the mark consisting of the word "hub," which is not distinctive. As a result, under the antidissection rule, any secondary meaning Opposer may have in its alleged GRUBHUB trademark is narrowly circumscribed to the exact trademark alleged and does not extend to any other feature of the trademark beyond the word "hub."
4. Each of Opposer's alleged marks is descriptive and weak.
5. Applicant is not infringing any applicable marks under federal or state law.
6. Without admitting that Applicant's mark GURUHUB would be likely to cause confusion, Opposer cannot show that it will suffer any harm from Applicant's use of mark.
7. Applicant's right to mark GURUHUB is protected by the First Amendment to the Constitution of the United States.
8. None of Opposer's alleged marks are famous.

9. Applicant is a small business that is harmed by Opposer's litigation tactics wherein Opposer attempts to enforce its alleged trademark rights beyond a reasonable interpretation of the scope of the rights legitimately granted to the trademark owner.
10. Opposer is not damaged by the registration of the GURUHUB mark by the Applicant.

ADDITIONAL DEFENSES

1. Regarding Opposer's claim to ownership of the trademark identified by Registration number 4,279,207 (the stylized servicemark "grubHub" in which the only capitalized letter is "H"), with a filing date of June 1, 2012 in International Commerce Class 25, the TTAB has set precedent in treating stylized letter marks essentially as design marks. (See *Textron, Inc. v. Maquinas Agricolas "Jacto" S.A.*, 215 U.S.P.Q. 162, 163 (T.T.A.B. 1982), citing cases.) As such, there is no likelihood of confusion between this and Applicant's mark.

Applicant reserves the right to assert additional defenses based on information learned or obtained during discovery.

WHEREFORE, Applicant requests that the Notice of Opposition and this proceeding in its entirety be dismissed on the merits and with prejudice, Opposer taking nothing. Applicant further requests that its trademark application be advanced and receive a Notice of Allowance.

Please direct all correspondence to the attention of:

Robert B. Reach, MBA
So Within Reach, LLC
22893 Country Ridge Parkway
McCalla, AL 35111
UNITED STATES
205-915-4040

Respectfully submitted,

So Within Reach, LLC

By its Chief Executive Officer,

Date: August 5, 2013 _____
_____/Robert B. Reach/_____
Robert B. Reach, MBA
Chief Executive Officer
So Within Reach, LLC
22893 Country Ridge Parkway
McCalla, AL 35111
UNITED STATES
205.915.4040

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Answer to Notice of Opposition was served on:

Steven L. Baron
Mandell Menkes LLC
1 N. Franklin Ave Suite 3600
Chicago, IL 60606
UNITED STATES

By first class mail, postage prepaid on this 5th day of August 2013.

Date: August 5, 2013 _____
_____/Robert B. Reach/_____
Robert B. Reach, MBA